

use expanded memory space. Yoshizawa does not teach the missing limitations, as Yoshizawa teaches inserting memory into expansion slots to increase a memory capacity of a computer system. However, Yoshizawa neither teaches nor suggests determining memory upgrade options to expand the number of memory devices based on the residual memory capacity of a computer system.

Therefore, for at least these reasons, the Examiner fails to establish a *prima facie* case of obviousness for claim 1.

The Examiner fails to establish a *prima facie* case of obviousness for claim 1 for at least the additional reason that the Examiner provides no support for the alleged suggestion or motivation to combine these two references. In this manner, the Examiner must provide a specific cite to a cited reference to support the alleged suggestion or motivation for the combination or modification. The Examiner has not fulfilled this requirement, as the Examiner merely concludes there would have been a suggestion or motivation for the combination without providing specific support. See, *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143.

Thus, for at least this additional reason, the Examiner fails to establish a *prima facie* case of obviousness for claim 1.

Claims 2-11 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 18-20:

The computer system of claim 18 includes a configuration routine that includes instructions to obtain memory configuration information, determine a memory capacity of the computer system and determine memory upgrade options to expand the number of memory modules based on a residual memory capacity. See discussion of claim 1 above. In particular, the Examiner fails to establish a *prima facie* case of obviousness for at least the reason that neither Yoshizawa nor Arai teaches or suggests a configuration routine including instructions to determine memory upgrade options to expand the number of memory modules based on residual

memory capacity of a computer system. Furthermore, a *prima facie* case of obviousness has not been established for claim 18 for at least the additional reason that the Examiner fails to provide specific support for the alleged suggestion or motivation to combine Arai and Yoshizawa.

Thus, for at least these reasons, withdrawal of the § 103 rejections of claims 18-20 is requested.

Rejections of Claims 21-31:

The method of claim 21 includes determining memory upgrade options to replace at least one memory device based on a residual memory capacity of a computer system.

Neither Yoshizawa nor Arai teaches or suggests determining memory upgrade options to replace at least one memory device based on the residual memory capacity of the computer system.

Contrary to the limitations of claim 21, neither Arai nor Yoshizawa teaches or suggests determining memory upgrade options to replace a memory device. In this manner, Arai does not specifically address the replacement of memory devices. Furthermore, although Yoshizawa teaches replacing installed memory with a memory having a larger capacity, Yoshizawa neither teaches nor suggests determining memory upgrade options based on a residual memory capacity of the computer system. Thus, for at least these reasons, a *prima facie* case of obviousness has not been established for claim 21. Furthermore, a *prima facie* case of obviousness has not been established for claim 21 for at least the additional reason that the Examiner fails to provide specific support for the alleged suggestion or motivation to combine Yoshizawa and Arai.

Thus, for at least these reasons, the § 103(a) rejections of claims 21-31 is requested.

Rejections of Claims 32-37:

The program storage device of claim 32 includes instructions for causing a programmable control device to determine memory upgrade options to replace one or more memory devices based on a residual memory capacity of a computer system.

Contrary to the limitations of claim 32, neither Yoshizawa nor Arai teaches or suggests these claim limitations. Furthermore, the Examiner fails to provide specific support for the alleged suggestion or motivation to combine Yoshizawa and Arai.

Therefore, for at least these reasons, withdrawal of the § 103(a) rejections of claims 32-37 is requested.

Rejections of Claims 38-40:

The computer system of claim 38 includes a configuration routine that includes instructions to determine memory upgrade options to replace one or more memory modules based on a residual memory capacity.

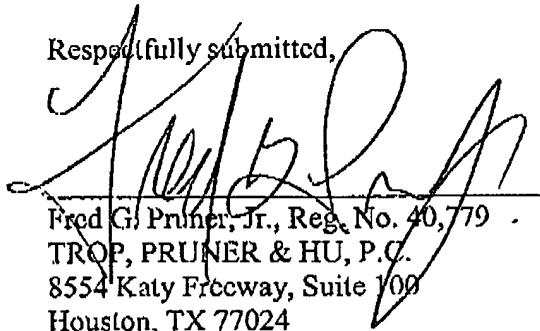
Contrary to the limitations of claim 38, neither Arai nor Yoshizawa teach such a configuration routine. Furthermore, the Examiner fails to provide specific support for the alleged suggestion or motivation to combine Arai and Yoshizawa.

Thus, for at least these reasons, a *prima facie* case of obviousness has not been established for claim 38; and withdrawal of the § 103(a) rejections of claim 38-40 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the § 103(a) rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (MCT.0102US).

Respectfully submitted,



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